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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,106	08/26/2003	Dennis M. Wiedeman	16356.828 (DC-01970A)	6423
27683	7590	03/21/2007		
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER GREY, CHRISTOPHER P	
			ART UNIT 2616	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/650,106

Applicant(s)

WIEDEMAN ET AL.

Examiner

Christopher P. Grey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-19, 23-28 and 31 is/are rejected.
- 7) ☒ Claim(s) 6, 13, 20-22, 29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, independent claims 1, 8, 15, 23 and 31 disclose SUT's are connected to and disconnected from a VLAN. The examiner contends that the claim as written implies that connecting and disconnecting are performed simultaneously or together.

Suggested correction: "SUTs are connected to or disconnected from a VLAN".

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 7, 8, 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6654347 in view of US Patent No. 6977900

**Claim 1** Claim 1 of U.S. Patent No. 6654347 discloses A system for dynamically implementing a plurality of virtual local area networks ("VLANs") across multiple sites, the system comprising: a first VLAN-capable switch located at a first site; a first uniquely identified system under test ("SUT"), controlled by a step diskette, located at said first site and connected to said first VLAN-capable switch via a first burn rack switch; a second VLAN-capable switch located at a second site remote from said first site; a second uniquely identified SUT, controlled by a step diskette, located at said second site and connected to said second VLAN-capable switch via a second burn rack switch; and means for connecting said first VLAN-capable switch to said second VLAN capable switch such that said first and second SUTs are connected to and disconnected from a single virtual private network (VPN).

Claim 1 of U.S. Patent No. 6654347 does not specifically disclose connecting or disconnecting the SUTs from a **VLAN**.

Claim 1 of U.S. Patent No. 6977900 discloses selected first and second SUTs dynamically

connected to form a first private VLAN; and selected remaining first and second SUTs dynamically connected to form a second private VLAN.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify US Patent No. 6654347 so that the SUTs are connected to a VLAN as disclosed by US Patent No. 6977900 as opposed to a VPN. The motivation for this modification is to perform testing functions within a virtual local area network.

**Claim 7, 14** Claim 1 of U.S. Patent No. 6654347 does not specifically disclose a private VLAN.

Claim 1 of U.S. Patent No. 6977900 discloses a private virtual local area network (see line 16).

**Claim 8** Claim 1 of U.S. Patent No. 6654347 discloses A system for dynamically implementing a plurality of virtual local area networks ("VLANs") across multiple sites, the system comprising: a first VLAN-capable switch located at a first site; a first uniquely identified system under test ("SUT"), controlled by a step diskette, located at said first site and connected to said first VLAN-capable switch via a first burn rack switch; a second VLAN-capable switch located at a second site remote from said first site; a second uniquely identified SUT, controlled by a step diskette, located at said second site and connected to said second VLAN-capable switch via a second burn rack switch; and means for connecting said first VLAN-capable switch to said second VLAN capable switch such that said first and second SUTs are connected to and disconnected from a single virtual private network (VPN).

Claim 1 of U.S. Patent No. 6654347 does not specifically disclose connecting or disconnecting the SUTs from a **VLAN**. Claim 1 also does not disclose **a plurality of SUTs**.

Claim 1 of U.S. Patent No. 6977900 discloses selected first and second SUTs dynamically connected to form a first private **VLAN** and selected remaining first and second SUTs dynamically connected to form a second private **VLAN**.

Claim 1 of U.S. Patent No. 6977900 discloses a plurality of first uniquely identified system under test (first SUTs) connected to the first VLAN-capable switch.

Claim 1 of U.S. Patent No. 6977900 discloses a plurality of second uniquely identified SUT (second SUTs) connected to the second VLAN-capable switch.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify US Patent No. 6654347 so that the SUTs are connected to a VLAN as disclosed by US Patent No. 6977900 as opposed to a VPN. The motivation for this modification is to perform testing functions within a virtual local area network.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8-12, 15, 16-19, 23-28, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US 5027343), hereinafter referred to as Chan in view of Brady et al. (US 5914938), hereinafter referred to as Brady.

**Claim 1, 8, 15, 23, 31** Chan discloses a first uniquely identified system under test located at a first site (**fig 8, SUT's 46 in remote site 1**) and a second uniquely identified SUT located at the remote site (**fig 8, see SUT's in 2<sup>nd</sup> and 3<sup>rd</sup> remote site**).

Chan discloses a switch at the local site (**fig 8, 25, see switch, where each site has a switch or terminal Col 4 lines 55-60, switching network**).

Chan discloses a plurality of SUT's within one site (**fig 8, SUT's 46 in remote site 1**).

Chan does not specifically disclose a connection between the first VLAN capable switch and the second VLAN capable switch such that the first and second SUTs are connected to and disconnected from a VLAN.

Brady discloses a first and second VLAN switch (**fig 1, 16**) connecting virtual LANs (**fig 1, 12, where each switch and its connected VLAN's are equivalent to a site, whether remote or local**).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the SUTs as disclosed within the invention of Chan to the switches as disclosed in Brady. The motivation for this combination is for testing in a virtual LAN. Furthermore the SUT's disclosed by Brady can be applied for testing purposes within a any site, such as the sites defined by the VLAN switches ad its connected VLAN's.

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**Claim 2, 3, 9, 10, 17, 18, 25, 26** The combined teachings of Chan and Brady do not specifically disclose the local site being a manufacturing facility.

It would have been obvious to one of the ordinary skill in the art at the time of the invention that a VLAN may be implemented in any facility, including a manufacturing facility.

**Claim 4, 11, 19, 27** Chan discloses a data terminal equipment connection at the remote site (**col 5, lines 39-32**), where it would have been obvious to one of the ordinary skill in the art at the time of the invention that the DTE is capable of being part of a customer site.

**Claim 5, 12, 28** Chan discloses a data terminal equipment connection at the remote site (**col 5, lines 39-32**), where it would have been obvious to one of the ordinary skill in the art at the time of the invention that the terminal equipment may be that of a server.

**Claim 16** Chan discloses a packet network (**fig 1, 22**), wherein a packet network is made equivalent to that of an IP network.

**Claim 24** Chan discloses wherein the customer site is connected to the remote site by a router (**see fig 8, 25, switch**).



4. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US 5027343), hereinafter referred to as Chan in view of Brady et al. (US 5914938), hereinafter referred to as Brady in view of the applicants admitted prior art. **Claim 7, 14** The combined teachings of Chan and Brady do not specifically disclose wherein the VLAN is private.

The applicants admitted prior art discloses wherein the VLAN is private (page 3 lines 1-5).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the combined teachings of Chan and Brady so as to employ the capability of dealing with private VLAN's, where the motivation to employ a private network is for security purposes.

#### ***Allowable Subject Matter***

5. Claims 6, 13, 20-22, 29, 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Or et al. (US 6532237) discloses an apparatus and method of enabling the debugging and testing of complex networks.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Grey whose telephone number is (571)272-3160. The examiner can normally be reached on 10AM-7:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on (571)272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Grey  
Examiner  
Art Unit 2616

C. Grey 3/17/07



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